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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/553,713

12/18/2006

Graham L. Hearn

12965/3

5809

757 7590 03/12/2010  
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EXAMINER

BASS, DIRK R

ART UNIT

PAPER NUMBER

1797

MAIL DATE

DELIVERY MODE

03/12/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/553,713	<b>Applicant(s)</b> HEARN ET AL.	
	<b>Examiner</b> DIRK BASS	<b>Art Unit</b> 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 November 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/17/05</u> . | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. Applicant's election with traverse of group III in the reply filed on November 12, 2009 is acknowledged. The traversal is on the ground(s) that the claims have a special technical feature linking independent claims 1 and 16. This is found persuasive; therefore the examiner withdraws the restriction requirement and considers claims 1-21 on the merits.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. **Claims 1-21** are rejected under 35 U.S.C. 103(a) as being unpatentable over Greenshields et al., US 5024821 (Greenshields), in view of Henry et al., USPA 2003/0000131 (Henry).

5. Regarding claims 1 and 14-16, Greenshields discloses a solvent extraction process for extracting a metal such as copper (abstract, col. 4, l. 38-53) using an organic solvent such as kerosene and a non-ionic extractant such as an oxime wherein the proportion of oxime in the solvent is between 5-15% by volume (see Example 1).

6. Greenshields fails to explicitly disclose using a conductivity enhancer in combination with the organic solvent and non-ionic extractant. However, Henry discloses using static dissipators such as Stadis in kerosene blends (§ 0065-0066).

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7. At the time of invention, it would have been obvious to one of ordinary skill in the art to combine the static dissipater of Henry with the method of Greenshields in order to prevent static build-up and large electrostatic discharges.

8. Regarding claims 2-8, Greenshields in view of Henry disclose monitoring the conductivity of the solvent extraction solution with a conductivity meter and conductivity probe (see Example 1). Greenshields in view of Henry fail to explicitly disclose adding conductivity enhancer to maintain the electrical conductivity above a minimum level. However, the examiner considers the level of conductivity to be a result effective variable which can be routinely optimized.

9. At the time of invention, it would have been obvious to a routineer in the art to maintain the conductivity of the solvent above 500 pS/m, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art (MPEP 2144.05, Part II, Section B).

10. Regarding claims 9-13, while Greenshields in view of Henry fail to explicitly disclose using conductivity enhancers disclosed in claims 9-13, it would have been obvious to one skilled in the art to use such additives since it has been held to be within the general skill of a worker in the art to select a **known** material on the basis of its suitability for the intended use as a matter of obvious design choice (MPEP 2144.07).

11. Regarding claims 17-21, Greenshields in view of Henry is relied upon in the rejections of claims 1-15 as set forth above.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DIRK BASS whose telephone number is (571) 270-7370. The examiner can normally be reached on Mon - Fri (9am-4pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vickie Kim can be reached on (571) 272-0579. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/DRB/  
Dirk R. Bass

*/Angela Ortiz/*

***Supervisory Patent Examiner, Art Unit 1797***